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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/715,209

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Andrew Weaver

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EXAMINER

WALSH, JOHN B

ART UNIT

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2151

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/715,209	<b>Applicant(s)</b> WEAVER ET AL.	
	<b>Examiner</b> John B. Walsh	<b>Art Unit</b> 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-33 and 35-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-33 and 35-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5, 12, 16, 18-20, 22, 25, 28-33, 35, 36, 47-50, 53 and 56 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 8-11, 25, 12, 64, 36, 36, 37, 42, 47, 28, 29, 25, 27-32, 47, 36, 42, 37, 48 and 63 of copending Application No. 10/747,696. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are anticipated by the claims of the copending Application. Claims 1-5, 12, 16, 18-20, 22, 25, 28-33, 35, 36, 47-50, 53 and 56 of the present application correspond to claims 1, 8-11, 25, 12, 64, 36, 36, 37, 42, 47, 28, 29, 25, 27-32, 47, 36, 42, 37, 48 and 63 are respectively of copending Application ‘696.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-13, 15-18, 28-33, 35-46 and 56-58 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 7,275,215 to Werndorfer et al.

As concerns claims 1 and 30, a computer implemented method for enabling perception of multiple online personas in an instant messaging communications session, the method comprising: identifying at least two identities within a communications environment to whom messages may be directed (fig. 3, user may select from available screen names for communication); and enabling a first persona of a user to be projected to a first of the identities while concurrently enabling a second persona of the same user to be projected to a second of the identities (col. 4, lines 1-20 and 59-62; column 10, claim 1), wherein the first persona is at least partially distinguishable from the second persona within the instant messaging communications service (fig. 3-different screen names); projecting the first persona of the user to the first of the identities (fig. 3); and concurrently projecting the second persona of the user to the second of the identities, wherein the first persona and the second persona are projected using the instant messaging communications service (fig. 3; user has multiple contacts it can contact and can thus simultaneously communicate with more than one user; also first persona and second persona

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could both be displayed where one is active and the other inactive); each persona comprising one or more self expression items (figure 7- buddy icon).

As concerns claims 2, 10, 35 and 36, further comprising associating the first persona with a first group of identities so that the first persona is projected to members of the first group of identities in a communications session, wherein the first of the identities is included within the first group of identities (column 12, claim 13).

As concerns claims 3, 35 and 36, further comprising associating the second persona with a second group of identities so that the second persona is projected to members of the second group of identities in a communications session, wherein the second of the identities is included within the second group of identities (column 12, claim 13-online, offline group).

As concerns claims 4, 6 and 10, the method of claim 1 further comprising associating a global persona (column 5, lines 5-7) with each of the identities and associating a different persona with a group of the identities with which the first of the identities is associated, wherein the first persona projected to the first of the identities comprises an amalgamation of the global persona associated with each of the identities and the different persona associated with the group of the identities (column 12, lines 21-35; figure 7, 701, 601,602).

As concerns claims 5, 7 and 11, the method of claim 6 wherein the global persona associated with each of the identities is overridden by the different persona associated with the group of the identities to the extent a conflict exists (column 6, line 37).

As concerns claim 8, the method of claim 1 further comprising associating a global persona (column 5, lines 5-7) with each of the identities and associating a different persona with the first of the identities, wherein the first persona projected to the first of the identities

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comprises an amalgamation of the global persona associated with each of the identities and the different persona associated with the first of the identities (column 12, lines 21-35; figure 7, 701, 601,602).

As concerns claim 9, the method of claim 8 wherein the global persona associated with each of the identities is overridden by the different persona associated with the first of the identities to the extent a conflict exists (column 6, line 37).

As concerns claim 12, the method of claim 1 wherein the communications session comprises an instant messaging communications session (abstract).

As concerns claim 13, the method of claim 12 wherein the identities are members of a buddy list, the buddy list including the online presence state of the identities (figure 3).

As concerns claim 15, the method of claim 1, further comprising selecting among the first and second personas for projection to a particular one of the identities based on an attribute of the particular identity (column 5, lines 60-65; column 6, line 37).

As concerns claim 16, the method of claim 1 further comprising receiving from the user a selection of at least the first and second personas (column 6, line 37; column 5, lines 60-65).

As concerns claim 17, the method of claim 1 further comprising selecting the first persona based upon an attribute of the first identity (column 5, lines 60-65; column 6, line 37).

As concerns claim 18, the method of claim 1 further comprising configuring the persona assigned to the first identity to change based upon the occurrence of a predetermined event (column 8, lines 48-59).

As concerns claim 28, the method of claim 1 wherein the user comprises a potential instant messaging sender, the first identity comprises a first potential instant messaging

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recipient, and the first persona is rendered to the first potential instant messaging recipient before communications are initiated by the potential instant messaging sender (persona and recipient previously used such that they have already been rendered).

As concerns claim 29, the method of claim 1 wherein the user comprises a potential instant messaging sender, the first identity comprises a first potential instant messaging recipient, and the first persona is rendered to the first potential instant messaging recipient after communications are initiated by the potential instant messaging sender (new contacts added communication).

As concerns claim 31, the method of claim 30 wherein the selected persona is rendered before communications are initiated (when user opens application the persona is rendered; persona listed on buddy list) by the potential instant messaging sender.

As concerns claim 32, the method of claim 30 wherein the selected persona is rendered after communications (persona is rendered after communications since it is still visible, also may be animated and updated which takes place after communication is initiated; persona can be rendered to active status from inactive status which would take place after communication initiated; also communication can be from a new contact not previously listed on contacts list) are initiated by the potential instant messaging sender.

As concerns claim 33, a buddy icon (fig. 7).

As concerns claim 37, the method of claim 30 wherein a persona is selected for use in an instant messaging communications session with a potential instant messaging recipient according to a hierarchy of selection (abstract-prioritization scheme).

As concerns claim 38, the method of claim 37 wherein selecting the persona according to a hierarchy of selection comprises first selecting a persona assigned to the potential instant messaging recipient if available; next selecting a persona assigned to a group containing the potential instant messaging recipient, if available; and next selecting a default persona, if available (col. 5, lines 40-60). The term “if” is a conditional statement that if not satisfied is not limiting.

As concerns claim 39, the method of claim 37 wherein selecting the persona according to a hierarchy of selection comprises appending one or more self-expression items of a higher-ranked persona to self-expression items of a lower-ranked persona (col. 5, lines 40-60; col. 4, lines 16-20 and 33-modifying preferences, which includes self-expression items (i.e. buddy icons)).

As concerns claim 40, the method of claim 37 wherein selecting the persona according to a hierarchy of selection comprises replacing one or more self-expression items of a lower-ranked persona with self-expression items of a higher-ranked persona (col. 5, lines 40-60; col. 4, lines 16-20 and 33-modifying preferences, which includes self-expression items (i.e. buddy icons)).

As concerns claims 41 and 42, locking or forbidding a persona assigned to a potential recipient (col. 6, lines 4-21- edit assignments, can set particular persona for particular services that a recipient is known to be on; col. 4, lines 16-20 and 33-modifying preferences

As concerns claim 43, the method of claim 30 further comprising changing the personality assigned a potential instant messaging recipient while conversing with the potential instant messaging recipient in an instant messaging communications session (col. 5, lines 40-60;



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col. 4, lines 16-20 and 33-modifying preferences, which includes self-expression items (i.e. buddy icons; inherent preferences can be modified while a communication session is on).

As concerns claim 44, the method of claim 30 further comprising receiving a persona associated with the potential instant messaging recipient and saving the received persona (add person to contact/buddy list).

As concerns claim 45, the method of claim 30 wherein the persona is provided by a third party (third party is the computer system).

As concerns claim 46, the method of claim 30 wherein the persona assigned to the potential instant messaging recipient is configured to change upon the occurrence of a predetermined event (col. 8, line 45-col. 9, line 57).

As concerns claims 57 and 58, the first and second personas comprise a buddy icon (fig. 7).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 19-27 and 47-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,275,215 to Werndorfer et al. as applied above.

Claims 47-55 recite various events, which occur to change the persona. These various events are obvious design choices. It would have been obvious to one of ordinary skill in the art, when provided with Werndorfer et al. '215 which discloses generating a response based on any type of event (col. 8, line 54), that the various events recited in claims 47-55, would have been obvious to set. Furthermore, such a modification is a combination of known elements providing predictable results.

#### ***Response to Arguments***

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John B. Walsh/  
Primary Examiner, Art Unit 2151